

REMARKS

In the Office Action, the Examiner rejected claim 25 under 35 U.S.C. § 112, second paragraph, as indefinite. Further, the Examiner rejected claims 17-24, 26, 27 and 34-39 under § 102(b) as anticipated by Engel '992. Further, the Examiner rejected these claims under §§ 102(f) or (g). Claims 17-27, 34-36, 38 and 39 were also rejected under obviousness-type double patenting over U.S. Patent No. 6,004,366. Claim 37 was rejected under obvious-type double patenting over U.S. Patent No. 5,613,992.

In response to this Office Action, Applicants have amended claim 25 to address the rejection under § 112, second paragraph. In particular, Applicants have added the term "cap" after "second end". The word "cap" was inadvertently omitted from claim 25 as originally presented. This amendment is made to address purely a typographical error. It should be clear that Applicants intended the word "cap" to be part of the claim. Therefore, this amendment should not be interpreted to be a narrowing amendment. Applicants have shown the marked up claim in the attached sheet entitled "Version with Markings to Show Changes Made."

Applicants strongly disagree with the various rejections under § 102(e), § 102(f) and § 102(g). Applicants' position on this is presented below. However, Applicants believe they have addressed the Examiner's concerns by presenting the following documents, enclosed herewith:

1. A Terminal Disclaimer to U.S. Patent Nos. 5,613,992 and 6,004,366.
2. A Certificate under 37 CFR § 3.73(b) that shows the assignee is empowered to act. This document also proves the common ownership of this application and the applications which resulted in U.S. Patent No. 6,004,366 and U.S. Patent No. 5,613,992.
3. A Declaration of Donald Francis Engel, one of the inventors, stating that he is the sole inventor of claims 17 and 34 herein, and that each of the inventions of these claims was fully described and supported in his original patent application Serial No. 08/344,371 (which issued as U.S. Patent No. 5,613,992).

A. Rejections under § 102(e) over Engel '992

Claims 17-24, 26, 27, and 34-39 were rejected under § 192(e) as anticipated by Engel '992. Applicants respectfully submit that this rejection is in error.

Section 102(e) is only applicable if the prior art patent, in this case Engel '992, has a filing date before the effective filing date of claims 17-24, 26, 27 and 34-39.

Claims 17-24, 26, 27, and 34-39, in this case, are fully supported by the disclosure of the original application Serial No. 08/344,371. Because it is fully supported by the disclosure of Serial No. 08/344,371, the effective filing date of these claims is the same as the filing date of application Serial No. 08/344,371. Engel '992 has the same 102(e) date as the effective filing date of claims 17-24, 26, 27, and 34-39. Because they have the same filing dates, § 102(e) cannot apply.

The attention of the Examiner is directed to MPEP § 201.11. There it is explained:

Any claim in a continuation-in-part application which is directed *solely* to subject matter adequately disclosed under 35 U.S.C. § 112 in the parent non-provisional application, is entitled to the benefit of the filing date of the parent non-provisional application.

MPEP § 201.11. As claims 17-24, 26, 27, and 34-39 are fully supported by application Serial No. 08/344,371, § 102(e) cannot apply.

Applicants respectfully refer the Examiner to the Rule 63 declaration signed by Donald Francis Engel attached to patent application Serial No. 08/344,371. This Rule 63 declaration provides the oath that Mr. Engel believes he was the inventor of the inventions described in that application (which eventually issued as U.S. Patent No. 5,613,992). In order to further expedite prosecution of this application, Applicants have submitted herewith another declaration of Mr. Engel. In this declaration, Mr. Engel states his belief that he is the sole inventor of the independent claims of this application.

Further, Applicants have submitted a Terminal Disclaimer to the '992 patent. The Certificate under Rule 3.73(b) also states that this application and the '992 patent are owned by Donaldson Company. The Declaration of Donald Francis Engel states that he is an inventor in both this patent application and application Serial No. 08/344,371 (which issued as U.S. Patent No. 5,613,992).

Applicants respectfully request that the rejection under § 102(e) over Engel '992 be withdrawn.

B. Rejections under § 102(f) or (g) over Engel '992

Claims 27-24, 26, 27, and 34-39 were rejected under §§ 102(f) or (g) because the Applicants allegedly did not invent the claimed subject matter.

Applicants disagree with this rejection. The Examiner is reminded that inventive entity is determined on a claim-by-claim basis. Every inventor listed as an applicant does not need to be an inventor of every claim. Section 102(f) requires that Applicants did not himself invent the subject matter sought to be patented. In fact, Mr. Engel did invent the subject matter of at least claims 17 and 34. As inventive entity does not require every inventor listed to be an inventor of every single claim, there is no derivation in this case. Section 102(f) is simply not applicable.

For similar reasons, § 102(g) is not applicable. Section 102(g) requires that the invention was made by another who had not abandoned, suppressed, or concealed it. In this case, Mr. Engel invented the subject matter of claims 17-24, 26, 27, and 34-39. His prior patent is the basis of domestic priority under 35 U.S.C. § 120. Therefore, the effective filing date of these claims and of Engel '992 are the same. Section 102(g) cannot apply in this case.

Applicants request that the rejections under § 102(f) and (g) be withdrawn.

C. Obviousness-type Double Patenting Rejections

Claims 17-27, 34-36, 38, and 39 were rejected for obviousness-type double patenting over U.S. Patent No. 6,004,366. Claim 37 was rejected for obviousness-type double patenting over U.S. Patent No. 5,613,992.

Applicants have submitted a Terminal Disclaimer that addresses each of U.S. Patent Nos. 6,004,366 and 5,613,992. Applicants do not necessarily agree with the Examiner's positions of obviousness-type double patenting. To expedite prosecution of this application, however, Applicants are willing to accept the common ownership requirements of a terminal disclaimer.

D. Summary

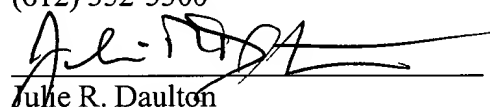
Claims 17-27 and 34-39 are pending. It is believed that all outstanding objections and rejections to these claims have been overcome, rendered moot, or obviated. Therefore, in view of the foregoing amendments and remarks, Applicants respectfully submit that the application is in condition for allowance. Applicants request reconsideration, reexamination, and a Notice of Allowance.

If the Examiner believes a telephone conference would advance the prosecution of this application, the Examiner is invited to telephone the undersigned at the below-listed telephone number.

Respectfully submitted,

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VERSION WITH MARKINGS TO SHOW CHANGES MADE

In the claims:

Claim 25 is amended as follows:

25. (Amended) A filter element according to claim 24 wherein:
- (a) said second end cap includes an insert molded therein.